REMARKS

[0001] Applicant respectfully requests reconsideration and allowance of all of the claims of the application. Claims 15-82 are presently pending. Claim 39 is substantively amended herein and claims 65 and 73 are amended for minor grammatical errors.

Formal Request for an Interview

[0002] If the Examiner's reply to this communication is anything other than allowance of all pending claims, then I formally request an interview with the Examiner. I encourage the Examiner to call me—the undersigned representative for the Applicant—so that we can talk about this matter so as to resolve any outstanding issues quickly and efficiently over the phone.

[0003] Please contact me to schedule a date and time for a telephone interview that is most convenient for both of us. While email works great for me, I welcome your call as well. My contact information may be found on the last page of this response.

Substantive Matters

Claim Rejections under § 102 and § 103

[0004] The Examiner rejects claims 39-46, 49-52, 60-70, 79, and 81-82 under 35 U.S.C. § 102(a) ("§102(a)"). For the reasons set forth below, the Examiner has not shown that the cited reference anticipates the rejected claims.

[0005] In addition, the Examiner rejects claims 15-38, 47-48, 53-59, 71-78, and 80 under 35 U.S.C. § 103(a) ("§103(a)"). For the reasons set forth below, the Examiner has not made a *prima facie* case showing that the rejected claims are obvious over the applied prior art of record.

[0006] Given the Examiner's failure to substantiate his rejections as set forth in detail below, applicant respectfully requests that the § 102(a) and § 103(a) rejections be withdrawn and the application be passed to issuance.

[0007] The Examiner's rejections are based upon the following references alone and in combination:

- **Babowicz et al 2005/0229013:** *"Babowicz" hereinafter;* US Patent Publication No. 2005/0229013 (published August 31, 2004); and
- **Hurtado et al 6,611,812:** *"Hurtado" hereinafter;* US Patent No. 6,611,812 (issued August 31, 2007).

Anticipation Rejections

[0008] Applicant submits that the anticipation rejections advanced by the Examiner for the claims referenced below are unsupported by the cited prior art and therefore such rejections must be withdrawn.

Babowicz fails to explicitly or implicitly recite each element of the claims rejected under §102(a).

[0009] The Examiner rejects claims 39-46, 49-52, 60-70, 79, and 81-82 under § 102(a) as being anticipated by Babowicz. In order to support a rejection on the basis of anticipation, the Examiner must establish that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."[1] As shown in the following paragraphs, Babowicz fails to disclose multiple claim elements, and therefore cannot act as a valid basis for supporting an anticipation type rejection.

Independent Claim 39

[0010] The Examiner indicates (Action, p. 2-3) the following with regard to claim 39:

> Regarding claim 39, Babowicz teaches a system for protecting media content, the system comprising:

[1] "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987); also see MPEP §2131.

a computing device;

media content stored on the computing device;

at least one digital rights management license stored on the computing device and describing allowed uses for the media content;

digital rights management software stored on the computing device and that when executed by the computing device, causes the computing device to use the digital rights management license to determine whether or not a requested use of the second data is allowed, and to prevent the requested use of the second data if the license does not permit the requested use (fig. 2, pars. 24-30); and

wherein the media content the at least one digital rights management license, and the digital rights management software were installed on the computing device from a single storage medium that contained the content the license, and the software (pars. 25-30).

[0011] Claim 39 is directed to a system for protecting media content that is stored on a computing device. This protection is accomplished through an executable digital rights management (hereinafter "DRM") software application and a DMR license. In specific, claim 39, as presently amended to correct an antecedent issue, recites that a system having these components whereby upon execution of the DRM software, which obtains user permissions from the DRM license also stored on the computing device, a requested use of the media content is either permitted or rejected. At no point is a copy of the media content made, for example, if the permission to do so is not given by the DRM software. Moreover, claim 39 further recites that “the media content, the at least one digital rights management license, and the digital rights management software were installed on the computing device from a single storage medium that contained the content, the license, and the software.”

[0012] Nowhere in Babowicz, let alone the cited and applied sections thereof, is there any disclosure of DRM other than a passing reference in ¶[0023] and related Fig. 1 to DRM files 112. While the Examiner cites to Fig. 2 and ¶¶[0024] to [0030] for support in this respect, applicant can discern no instance therein wherein DRM is disclosed or taught. Applicant submits the reason why there is only passing reference to DRM is because Babowicz is unconcerned about this type of data or technology. The invention of Babowicz is directed to "an apparatus and method for concealing digital content on a physical medium such as, for example, a CD that is recorded using a computer recording system and that permits improved control over the copying and distribution of the content stored on the CD." ¶[0018]. Nowhere in Babowicz is there any disclosure or even hint that any digital content is prevented from being copied from the computer (a hallmark of DRM objectives); Babowicz is only concerned about interfering with the enjoyment of copied data in certain instances. In specific, Babowicz teaches creating compact discs through a creation process wherein media content from two different sessions (*e.g.*, audio files from an audio CD format from a first session and MP3 audio format files from a second session) may be combined onto a single disc. The system may recognize that the first session (corresponding to the audio files from the audio CD) may have digital content concealment (*see*, [0028]) such that only the files from the second session may be further copied for personal use.

[0013] Consequently, the failure of Babowicz to disclose all of the elements and features of claim 39 renders the rejection improper. Accordingly, applicant requests the Examiner to withdraw the rejection of claim 39 on this basis.

Dependent Claims 40-44

[0014] These claims directly or indirectly depend upon independent claim 39, and have not been rejected or objected to on any basis other than their dependency on claim 39. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable, there being no other reasons for rejection, and applicant submits that these dependent claims are therefore in condition for allowance.

Independent Claims 45, 50, 60, and 68

[0015] Applicant submits that Babowicz does not anticipate these claims for at least the same reasons as discussed above with respect to claim 39. These claims recite similar language to claim 39, including recitations directed to DRM licenses, DRM software and media content interacting with computing devices and storage media in manners simply not taught by the cited and applied sections of Babowicz. Applicant submits that these claims are allowable for at least the same reasons as discussed above.

[0016] Consequently, Babowicz does not disclose all of the elements and features of these claims. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

Dependent Claims 46, 49, 51-52, 61-67, 69-70, 79 and 82

[0017] These claims ultimately depend upon one of the independent claims 45, 50, 60, and 68. As discussed above, these claims are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Independent Claim 81

[0018] Applicant submits that Babowicz does not anticipate this claim for at least similar reasons as discussed above with respect to claim 39. Claim 81 recites similar language to claim 39, including recitations of preventing an audio player configured to read digital data in a second format from actually reading digital data stored in a first format. Thus, the prevention of playing audio without any license is a method that is simply not taught by the cited and applied sections of Babowicz. Applicant submits that claim 81 is allowable for at least the same reasons as discussed above.

[0019] Consequently, Babowicz does not disclose all of the elements and features of this claim. Accordingly, Applicant asks the Examiner to withdraw the rejection of this claim.

Dependent Claim 82

[0020] This claim ultimately depends upon independent claim 81. As discussed above, claim 81 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, claim 82 may also be allowable for additional independent reasons.

Obviousness Rejections

Lack of *Prima Facie* Case of Obviousness (MPEP § 2142)

[0021] Applicant disagrees with the Examiner's obviousness rejections. Arguments presented herein point to various aspects of the record to demonstrate that all of the criteria set forth for making a *prima facie* case have not been met. To establish *prima facie* obviousness of a claimed invention, all of the claim recitations must be taught or suggested by the prior art[1] and "all words in a claim must be considered in judging the patentability of that claim against the prior art."[2] Further, if prior art, in any material respect teaches away from the claimed invention, the art cannot be used to support an obviousness rejection.[3] Moreover, if a modification would render a reference unsatisfactory for its intended purpose, the suggested modification / combination is impermissible.[4]

No permissible combination of Babowicz and Hurtado explicitly or implicitly teaches or suggests each element of the claims rejected under §103(a).

[0022] The Examiner rejects claims 15-38, 47-48, 53-59, 71-78, and 80 under 35 U.S.C. § 103(a) as being unpatentable over Babowicz and Hurtado.

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[1] *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)

[2] *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)

[3] *In re Geisler*, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed Cir. 1997)

[4] See MPEP § 2143.01

Applicant respectfully traverses the rejection of these claims and asks the Examiner to withdraw the rejection of these claims.

Independent Claims 15 and 27

[0023] Applicant submits that the combination of Babowicz and Hurtado fails to teach or even suggest the concept of DRM as recited in these claims.

[0024] As was clearly shown above, Babowicz does not teach, much less suggest the concept of a DRM license, let alone a DRM license that is simultaneously stored with the media content as well as the DRM software wholly within a session stored on a single medium. Babowicz cannot possibly be construed to teach or even suggest at least these recitations of claim 15.

[0025] Hurtado does not remedy this deficient teaching. As tacitly acknowledged by the removal of the previous §102 rejection of claim 15 as anticipated by Hurtado, the Examiner correctly interprets this reference as falling short of teaching these recitations in claim 15. In specific, Hurtado does not teach or even suggest creating a storage medium that has more than one session wherein the second session "[contains] digital data stored in a second format" such that the second session also includes "at least one digital rights management license describing allowed uses for the digital data," and also includes "digital rights management software[.]"

[0026] As shown above, no permissible combination of Babowicz and Hurtado teaches or suggests all of the elements and features of claims 13 and

27. Accordingly, Applicant asks the Examiner to withdraw the rejection of these claims.

Dependent Claims 16-26 and 28-46

[0027] These claims ultimately depend upon independent claim 15 or 27. As discussed above, claims 15 and 27 are allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Dependent Claims

[0028] In addition to its own merits, each dependent claim is allowable for the same reasons that its base claim is allowable. Applicant requests that the Examiner withdraw the rejection of each dependent claim where its base claim is allowable.

Dependent Claims 47-48

[0029] These claims ultimately depend upon independent claim 45. As discussed above, claim 45 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Dependent Claims 53-59

[0030] These claims ultimately depend upon independent claim 50. As discussed above, claim 50 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

Dependent Claims 71-78

[0031] These claims ultimately depend upon independent claim 68. As discussed above, claim 68 is allowable. It is axiomatic that any dependent claim which depends from an allowable base claim is also allowable. Additionally, some or all of these claims may also be allowable for additional independent reasons.

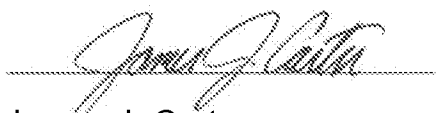
Conclusion

[0032] All pending claims are submitted as being in condition for allowance. Applicant respectfully requests reconsideration of this application in view of the amendments and remarks set forth herein. If any issues remain that prevent issuance of this application, the **Examiner is urged to contact the undersigned before issuing a subsequent official communication**.

[0033] Applicants submit that this response has not generated any additional claim fees. Should additional claim fees be required, please charge them to Deposit Account No. 07-1897. Should additional time be necessary in order for this response to be considered timely, please consider this communication as such supplemental petition and charge the additional fee(s) to Deposit Account No. 07-1897.

Sincerely,

GRAYBEAL JACKSON LLP



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